

### REMARKS

Reconsideration of the application is respectfully requested. Entry of the present amendment is respectfully requested as it is believed to place the claims in condition for allowance or in better form for consideration on appeal.

Claims 34-42 are currently pending and at issue. Claims 34-36 have been amended. New claims 37-42 have been added.

Claims 34-36 have been amended to specify compounds containing the tripeptide sequence arginine-glycine-aspartic acid (RGD). Support for this amendment is found in the specification. *See, e.g.*, Specification at p. 11, lines 1-16; and original claim 10.

New claims 37-39 are directed to a library of compounds, specifically tethered tripeptides. Support for new claims 37-39 is found in the specification. *See, e.g.*, Specification at p. 4, line 10 to p. 9, line 5; Figure 1; pp. 25-27, Tables 1-3; p. 33, line 23 to p. 37, line 7; pp. 35-37 (Tables 4-6); and p. 38, lines 6-12.

New claims 40 and 41 are directed to a method of screening for a compound by assaying the library of compounds recited in claim 37 against an etiological agent to identify compounds having antibacterial, antifungal, antiviral, or antineoplastic activity. New claim 42 is directed to an assay kit for the identification of compounds having antibacterial, antifungal, antiviral, or antineoplastic activity using the library of compounds recited in claim 37. Support for claims 40-42 is found in the specification. *See, e.g.*, Specification at p. 18,

lines 4-14; p. 19, line 12 to p. 20, line 3; and p. 20, line 8 to p. 29, line 6 (Example 1).

No new matter has been added.

#### **Examiner Interview**

The Examiner is thanked for all courtesies extended to Applicants' attorneys, S. Peter Ludwig and Dianna Goldenson, during the telephone interview held on May 12, 2005. During the interview, the Examiner agreed that claims limited to compounds that contain the RGD tripeptide sequence would likely be allowable. Accordingly, claims 34-36 have been amended, as discussed in the interview.

Additionally, during the interview, Applicants proposed the submission of new claims to a library of compounds and to a method of screening a library of compounds, wherein the library can be utilized as a research tool. The Examiner agreed to consider these new claims, particularly in view of MPEP § 2107.01, which states that "research tools ... have a clear, specific and unquestionable utility."

#### **Rejection Under 35 U.S.C. § 112, First Paragraph**

Claims 34-36 have been rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter not supported by the specification. The Examiner states that this is an enablement rejection.

The Examiner acknowledges that the specification is enabling for tethered tripeptides that are structurally related to RGD compounds. See Office Action at p. 2, ¶5. Claims 34-36 have been limited to compounds that contain the RGD tripeptide sequence. Therefore, this rejection should be withdrawn.

New claims 37-42 call for a library of compounds (claims 37-39), a method of screening using the library of compounds (claim 40), and an assay kit using the library of compounds. These compound libraries are useful as a research tool and can be used to screen for, identify, and assay target compounds in connection with research and drug discovery. See Specification at p. 19, lines 12-18.

The Examiner appears to require that a specific biological activity be known for the claimed compounds in order to enable those of ordinary skill in the art how to make and especially how to use the claimed invention. However, the primary utility of the claimed library of compounds is not related to any particular biological activity. Rather, the primary utility of the library is its use as a research tool, wherein the library may be screened to identify individual compounds having certain desired biological activity (e.g., antibacterial, antifungal, antiviral, or antineoplastic activity).

According to the MPEP, "Many research tools such as gas chromatographs, screening assays, and nucleotide sequencing techniques have a clear, specific and unquestionable utility (e.g., they are useful in analyzing compounds)." MPEP § 2107.01, *Research Tools*. Thus, those of ordinary skill in the art would know how to use the libraries of compounds called for in claims 37-42 as research tools - i.e.,

to assay the libraries against etiological agents or in tests or assays in order to identify compounds having antibacterial, antifungal, antiviral, antineoplastic or other desired pharmaceutical biological or chemical activity. See Specification at p. 19, line 29 to p. 20, line 3.

Further, on information and belief, the applicant has entered into several license agreements with various U.S. and Canadian companies granting such companies the right to use and screen the compound libraries called for in the present claims in connection with their respective drug research and development programs. Therefore, those of ordinary skill in the art would know how to use (and are currently using) the claimed libraries of compounds as a research tool.

Additionally, the specification discloses representative examples of the claimed tethered tripeptides (see, e.g., pp. 25-27, Tables 1-3; and pp. 35-37, Tables 4-6). These examples constitute a representative cross-section of the compounds called for in the general formulas set forth in claims 37-42. The specification also discloses methods of preparing several of the claimed compounds (see, e.g., p. 33, line 23 to p. 37, line 7), including detailed processing steps, such as particular reagents, filtrations, washes, and reaction times (see, e.g., p. 34, line 21 to p. 35, line 5). Thus, those of ordinary skill in the art would know how to make the claimed libraries of compounds.

In view of the foregoing, the specification contains all of the information required to enable a person of ordinary skill in the art to make and use the claimed invention.


### Conclusion

In view of the above amendments and remarks, it is respectfully requested that the application be reconsidered and that all pending claims be allowed and the case passed to issue.

If there are any other issues remaining, which the Examiner believes could be resolved through either a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

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Respectfully submitted,

By:   
Dianna Goldenson  
Reg. No. 52,949  
Attorney for Applicants

Darby & Darby P.C.  
Post Office Box 5257  
New York, NY 10150-5257  
212-527-7700 (tel)  
212-527-7701 (fax)